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Heiko Glienicke

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Muncy, Geissler, Olds & Lowe, PLLC
P.O. BOX 1364
FAIRFAX, VA 22038-1364

EXAMINER

CHOI, JACOB Y

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/721,358 | Applicant(s) GLIENICKE ET AL. | |
| | Examiner JACOB Y. CHOI | Art Unit 2885 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 21-28 is/are pending in the application.
 4a) Of the above claim(s) 21-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Examiner acknowledges that the applicant has amended claim 1, canceled claims 10-20, and newly added claims 21-28. Previously, applicant(s) have added claims 20-21, while claim 20 is now being canceled, newly added claims 21-28 are misnumbered. Appropriate correction is required. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the optical light guide (6) and the light rotor (7) are formed as a single piece must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Election/Restrictions

Newly submitted claims 21-28 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the applicant presents claim directed to an invention independent of the invention previously claimed. For example, claimed limitations of "*an axis of rotation*", "*an integral optical light guide*", "*maximum width*", "*an inner wall*", & "*an annular outer member*" ... etc. has not been previously claimed nor treated by the examiner.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Note: Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA1974).

Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Claims **1-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al. (USPN 5,093,764) in view of Snider (USPN 6,860,224).

Regarding claim 1, Hasegawa et al. discloses a combined scale and corona illumination, wherein the scale (e.g., 23a; Figure 1) is a part of a panel (23 and 7) that is designed to work together with the control element (e.g., column 2, lines 35-55; "... *an outer knob 2 and an inner knob 3 are coaxially provided on a panel surface 23 with a graduation 23 thereon*") an optical light guide (e.g., 6) that includes two parts (e.g., 6d and 6c), which are partially separated by an annular slot (e.g., Figure 2), such that parts

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of the panel engage (e.g., 23 and 7) or project into the slot (7), a light rotor (e.g., 2) that extends towards the optical light guide (e.g., 6) to a height necessary for light transport (column 3, lines 40-50; "... *the panel surface light guide 6 is divided into an outer knob illuminating portion 6c as a portion internally of the shield plate 7 and a panel surface illuminating portion 6d externally thereof*"), and a light source (e.g., 24) located below (Figure 2) the light rotor (e.g., 2).

Hasegawa et al. disclose the claimed invention, except for the details of the optical light guide and the light rotor are formed as a single piece.

However, Snider teaches similar indicator knob with over molded appliqué where the optical light guide and the light rotor are formed as a single piece (e.g., 22, 26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the light guide and the light rotor to be a single piece. The following modification would have minimized number of working parts within the device. Also, the modification would further yielded to predictable results of improving scale illumination (e.g., scale/corona) by minimizing the light lost, during light-rays transmitting from first to second body. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007). Also, it has been held that forming in one piece an article, which has formerly been formed in two pieces, and put together, involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claim 2, Hasegawa et al. further discloses the scale around the rotary knob of the control element are symbols (Figure 1), which are backlight in the night design (columns 1-2, lines 5-15; "... *use is expected at night or at dark places ... the*

panel surface 23 is lit to effect illumination so that the apparatus can be used at night ... illumination for the index can be attained, and visibility at night is enhanced, thus solving the aforementioned problem of the prior art.") and are easily recognizable in the daylight design by establishing appropriate contrast with their surroundings (columns 1-2, lines 5-15; "... *the inner knob light guide or the knob housing is formed from a colored transparent member*").

Regarding claim 3, Hasegawa et al. further discloses the symbols are produced by a laser, injection-molding, or film technique (column 3, lines 30-40; "... *in order to uniformly illuminate a graduation 23a applied to the panel surface 23 by suitable means, for example, such as a printed film*").

Regarding claims 4 and 5, Hasegawa et al. discloses the corona is illuminated in the night design as a luminous ring around the rotary knob.

However, failed to specify that during day time operation, the corona and the rotary knob are not illuminated in the daylight design and thus very difficult.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify the on/off or dimming function of the illuminated panel system of the vehicle (column 1, lines 1-10; "... *an air conditioning apparatus and an acoustic apparatus, and more specifically, to a coaxial knob provided with an illuminating device for facilitating an operation thereof at night*"). The reference does not explicitly teach the feature of turning the illuminated panel system on/off, however in a common vehicle environment includes the feature so that the user/driver may turn off the headlight off during day-time driving. Alternatively, the user/driver may dim the

interior lighting to better focus on the road. Thus, the following would save energy/battery use overall. See MPEP 2144.

Regarding claim 6, Hasegawa et al. further discloses the brightness of the scale and corona is regulated by an appropriate wall thickness in the symbol area (e.g., Figure 1; column 3, lines 30-40; "... *substantially closed area is provided on the panel surface 23, and the panel surface light guide 6a is provided with a through-hole 6b through which the inner knob light guide 4 extends*").

Regarding claim 7, Hasegawa et al. further discloses the brightness of the scale and corona is regulated by at least one light-diverting bevel (e.g., 6a; column 3, lines 30-40) provided on an underside of the optical guide (e.g., 6) on a circumferential side.

Regarding claim 8, Hasegawa et al. further discloses the optical light guide is fixed relative to the control element.

Regarding claim 9, Hasegawa et al. further discloses the optical light guide is adjusted in functional combination with the light rotor (column 3, lines 30-40).

Response to Arguments

Based on applicant's amendment, the arguments with respect to claims **1-9** have been considered but are moot in view of the different ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB Y. CHOI whose telephone number is (571)272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jacob Y Choi
Primary Examiner
Art Unit 2885

JC

/Jacob Y Choi/
Examiner, Art Unit 2885